

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AZIZ HASSAN,
GREGORY BORSINGER, and TERESA P. KARJALA,

Appellants

Appeal 2008-3522
Application 10/666,488¹
Technology Center 1700

Decided: July 18, 2008

Before CAROL A. SPIEGEL, JEFFREY T. SMITH, and
MARK NAGUMO, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application 10/666,488 filed 19 September 2003, titled *Novel Multifunctional Polymer for Use in Hot Melt Adhesive Applications*. The real party in interest is listed as HRD Corp. (Appeal Brief filed 18 June 2007 (“Br.”), at 4.)

A. Introduction

Aziz Hassan, Gregory Borsinger, and Teresa P. Karjala (“Hassan”) appeal from the final rejection of claims 1, 3-16, and 18-27. (Br. 4.) The only other pending claims, claims 31 and 32, have been withdrawn from consideration and are not before us. (*Id.*)

The claimed subject matter relates to adhesive hot melt compositions and cellulosic articles formed using such compositions.

The Examiner has maintained the following rejections:²

- a. Claims 1 and 3-15 stand rejected for obviousness-type double patenting in view of claims 1-16 of Yalvac.³
- b. Claims 1 and 3-15 stand rejected under 35 U.S.C. § 102(e) in view of Yalvac.
- c. Claims 1, 3-16, and 18-27 stand rejected under 35 U.S.C. § 102(b) in view of Werenicz.⁴

² Examiner’s Answer mailed 7 September 2007 (“Ans.”), at 4.

³ Selim Yalvac *et al.*, *Thermoplastic Marking Compositions*, U.S. Patent 6,552,110 B1 (22 April 2003), based on application 09/529,626, which is the national stage of international application PCT/US98/22123, filed 19 October 1998, which has been accorded a § 371(c) date of 12 June 2000. Teresa Karjala is listed among the inventors of this patent.

⁴ Harald Werenicz *et al.*, *Disposable Articles Having a Continuous Thermoplastic Coating Comprising a Metallocene Polyolefin*, U.S. Patent 6,120,887 (19 September 2000). Teresa Karjala and Selim Yalvac are listed among the inventors of this patent.

Representative claim 1 reads as follows:

Claim 1:

A hot melt adhesive composition consisting essentially of:

A) from about 40 to 100 percent by weight (based on the final weight of the hot melt adhesive composition) of a homogeneous ethylene/a-olefin interpolymers wherein:

1) the homogeneous ethylene/a-olefin interpolymers is present in an amount of from about 60 to about 85 percent by weight (based on the final weight of the hot melt adhesive composition) and the homogeneous ethylene/a-olefin interpolymers is characterized by having:: [sic]

i) a density of from about 0.880 to about 0.930 g/cm³;

ii) a number average molecular weight (Mn) of from about 1,000 to about 9,000; and

iii) a Brookfield Viscosity (measured at 300°F) of from about 500 to about 7,000 cP and

2) the hot melt adhesive composition is characterized by having:

i) a Brookfield Viscosity (measured at 350°F) of from about 400 to about 2,000 cP;

ii) a Peel Adhesion Failure Temperature ("PAFT") of greater than or equal to 110°F; and

iii) a Shear Adhesion Failure Temperature ("SAFT") of greater than or equal to 140°F; and

B) from about 0 to about 60 percent by weight (based on the final weight of the hot melt adhesive composition) of one or more tackifiers.

(Claims App., Br. 31; indentation added.)

Independent claim 16 covers "[a] cellulosic article using a hot melt adhesive composition, the adhesive composition consisting essentially of"

the hot melt adhesive recited in claim 1. (Claims App., Br. 36-37.)
Claims 26 and 27 depend from claim 16 directly and indirectly, respectively, and recite that the cellulosic article is selected from a list of materials that includes paper. (*Id.* at 40.)

Findings of fact throughout this Decision are supported by a preponderance of the evidence of record.

B. Discussion

a. Yalvac

The Examiner determines that Yalvac, particularly claims 1 and 2, covers compositions that are “identical in scope and compositional limitations, possessing identical physical characteristics” (Ans. 4) to the subject matter covered by claims 1 and 3-15. The Examiner concludes that claims 1 and 3-15 are unpatentable over claims 1-16 of Yalvac under the judicially created doctrine of obviousness-type double patenting. (*Id.*)

Hassan argues first that because HRD is the sole assignee or owner of the patent rights, the obviousness-type double patenting rejection is improper. (Br. 13-15; Reply Br. 5-8.) Hassan argues further in its Reply Brief that Patent Office Rules 37 C.F.R. §§ 1.130 and 1.321 require that there be a common assignee to support a terminal disclaimer. (Reply Br. at 6-8.)

These arguments are without merit. Rule 130 has nothing to do with an obviousness-type double patenting rejection. Rule 130 provides that a reference that is not prior art under § 102(b) may be removed as a reference under § 103 by filing a terminal disclaimer (37 C.F.R. § 1.130(a)(1)) and by

filing a declaration that the reference and the application containing the rejected claims are commonly owned (37 C.F.R. § 1.130(a)(2)).

Rule 321 does not require common ownership. *See* 37 C.F.R. § 1.321(d), which provides conditions under which a terminal disclaimer must be filed when the patent application is “not commonly owned but was disqualified under 35 U.S.C. 103(c) . . .” The existence of a common inventor, here, Dr. Theresa P. Karjala, suffices to insist on a terminal disclaimer provided that the obviousness double patenting rejection is valid on its merits.

Hassan’s second argument is that the claimed compositions on appeal would not have been obvious over Yalvac. (Br. 15-18.) Hassan does not argue for the patentability of specific claims. Accordingly, we consider only claim 1. The remaining claims subject to this rejection stand or fall with claim 1 as provided by 37 C.F.R. § 41.37(c)(1)(vii). In particular, Hassan argues that:

it is clear that the compositions of the pending claims are different from those of the references. Although there may be some similarities in density and molecular weight, the inventive ethylene/alpha-olefin interpolymers are still different from those described in the reference *because of the novel manner* in which these ethylene/alpha-olefin interpolymers were produced, using multiple catalysts that produce polymers with either a high or a low molecular weight, in contrast to the polymers described in the reference.”

(Br. 17:28-33; emphasis added.)

This argument is without merit because neither claim 1 nor any of claims 3-15 recites the manner in which the polymers are to be made. Limitations are not to be read into the claims from the specification. *In re*

Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1369 (Fed. Cir. 2004) (it is improper to read limitations from preferred embodiments in the specification into the claims). Although claims to products that are presented in product-by-process format exclude prior art materials that do not have the properties that arise only as a result of the recited process,⁵ the present claims are pure product claims and are not so limited.

Similarly, Hassan argues that particular polymers described in Yalvac (Br. 23-24, citing Yalvac Table 4) do not lie within the scope of the claimed subject matter because the Yalvac polymers were not produced under the same conditions as the “ethylene/alpha olefin polymers of the present invention” (Br. 24). This argument also fails because the appealed claims are not limited by the manner of production of the polymers.

Hassan has not raised any other substantive arguments in traverse of the rejection for obviousness-type double patenting over Yalvac.

Accordingly, we AFFIRM this rejection.

The Examiner has also rejected claims 1 and 3-15 under 35 U.S.C. § 102(e) in view of Yalvac. (Ans. 4-5.) The Examiner finds that Yalvac describes hot melt adhesive compositions. (Final Rejection⁶ 5, citing Yalvac 7:48-53; Ans. 7.) The Examiner also finds that ultralow molecular weight ethylene/alpha-olefin polymers having a number average molecular

⁵ "If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317 (Fed. Cir. 2006) (quotation and citation omitted).

⁶ Office Action mailed 17 February 2006 (“Final Rejection”).

weight less than 11,000 are described. (Final Rejection 6, citing Yalvac 9:11-19; Ans. 8.) The Examiner finds that the composition and molecular weight of these polymers indicate that they are essentially identical, and that the adhesive compositions are essentially identical to those recited in the claims. (Final Rejection 6; Ans. 8-9.) Based on these findings, the Examiner concludes that the other recited characteristics, in particular the Brookfield Viscosity and the Peel Adhesion Failure Temperature (“PAFT”) and the Shear Adhesion Failure Temperature (SAFT), would be inherent in the compositions. (Final Rejection 6-7; Ans. 9.) In the Examiner’s words, “[t]hese identical compositions would have identical inherent characteristics” (Final Rejection 6.)

Hassan again argues that Yalvac is an improper reference under § 102(e) because HRD is the sole assignee.

There is no merit to this argument. Section 102(e) requires the reference patent to have been granted to another based on an application filed in the United States before invention by the applicant. Section 102(e) sets no limitations as to who owns the patent rights.

Hassan argues further that Yalvac “does not teach a hot melt adhesive composition, or ethylene/alpha olefin interpolymers produced using a dual catalyst system as described” in its specification. (Br. 22.) The first argument is without merit. As the Examiner pointed out at least as early as the final rejection, Yalvac refers to the disclosed compositions as “hot melt adhesives.” (Final Rejection 5, citing Yalvac 7:48-53.) Moreover, it is the properties of a composition, not what it is called, or for what uses it may be intended, that determine whether or not it falls within the scope of the

claimed subject matter. As the predecessor to our reviewing court stated, “[f]rom the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing.” *In re Papesch*, 315 F.2d 381, 391 (CCPA 1963).

Hassan argues further that Yalvac discloses properties of ethylene/alpha-olefin polymers used in the invention only in Table Four. (Br. 23:17-19.) Hassan overlooks the disclosure on which the Examiner relies, namely Yalvac column 9, lines 20-25. It is error to restrict the teachings of a reference to particular embodiments in the examples: section 102 requires only that the invention be described. Moreover, Hassan asserts that Yalvac only describes polymers A and B of Table Four: in Hassan’s words, “the remaining polymers listed in that table are simply unknown; nowhere does the reference describe them, nor does one know what either of the two comparative polymers are.” (Br. 23:25-27.) This argument is without merit. Yalvac states that “[t]he polymers utilized in the binder formulations are as set forth in the following Table Four, wherein each is a substantially linear ethylene/1-octene copolymer, available from The Dow Chemical Company.” (Yalvac 16:31-34.)

In view of these misinterpretations of the reference, we are not inclined to accord much credence to Hassan’s arguments. As for the alleged difficulty arising from the difference in reported values of viscosity in sample D and comparative sample E, we observe first Hassan has not challenged expressly any of the polymers as not meeting the limitations recited in claim 1. Moreover, it is clear that polymers B, D, E, and F all meet the density limitation recited in claim 1, and that Polymers A and C may meet the density limitation depending on the scope of variation

accorded to the limit “about 0.880 g/cm³”—another issue Hassan has failed to raise.

Hassan’s second argument, as to the manner of making the polymers, is irrelevant to the presently claimed subject matter, as explained *supra*. Hassan has not raised other arguments to distinguish the claimed subject matter from the compositions described by Yalvac.

In conclusion, Hassan has not satisfactorily explained in what way the compositions disclosed by Yalvac differ from the claimed subject matter.

For the foregoing reasons, Hassan has failed to demonstrate reversible error in the rejection of claims 1 and 3-15 as anticipated by Yalvac. Accordingly, we AFFIRM the rejection.

b. Werenicz

The Examiner finds that Werenicz describes hot melt adhesive coating compositions that meet the limitations of claim 1, but for express teachings of the recited PAFT and SAFT adhesive properties. (Ans. 5-6.) According to the Examiner, Werenicz “provides the identical composition with the identical number average molecular weight used in identical compositional limitations, and would inherently produce and possess these characteristics. Nothing is recited to indicate, or other wise provide reasoning, why the reference does not show all elements of the claimed invention.” (Ans. 6.)

With regard to claim 1, Hassan argues that Werenicz “does not teach a hot melt adhesive composition, or ethylene/ α -olefin interpolymers produced using a dual catalyst system as claimed herein.” (Br. 26.) Neither of these arguments have merit. Werenicz teaches, in the first sentence of the section styled “Detailed Description of the Invention” that “[i]n the preferred

method of coating the thermoplastic composition of the present invention, a melted *hot melt adhesive*, preferably substantially air-free, is released from a coating or release device in such a way that it exits the device as a continuous film.” (Werenicz 4:46-50; emphasis added.) The Examiner has also identified other passages, e.g., at column 14, lines 16-23 and 53-60, that identify the disclosed compositions as hot melt adhesives. Hassan’s second argument fails because the claims on appeal do not recite that the polymers are made by a dual catalyst system as alleged by Hassan.

Hassan also appears to argue that Werenicz is not prior art, at least under § 103(c). (Br. 27.) These arguments are irrelevant to a rejection under § 102.

With regard to claim 16, Hassan argues that Werenicz “fails to teach [the] use of cellulosic products as a substrate for adhesives.” (Br. 27.) Hassan makes a similar argument regarding claims 26 and 27, which recite specific cellulosic substrates, including paper. Werenicz, however, states that “paper, durable fabric, as well as any other material available as web may be coated with this coating method.” (Werenicz 3:61-63.) Thus, Hassan’s argument is contradicted by the evidence of record.

Finally, Hassan argues that the properties of the claimed invention are not inherent in Werenicz, and that because Werenicz did not appreciate or recognize properties such as the molecular weights or viscosities, the rejection for anticipation is improper. (Br. 28-29, quoting and citing *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993) [sic: *In re Naylor*, 369 F.2d 765, 768 (CCPA 1966)]. This argument has its proper place in the law of obviousness, not anticipation. It is well settled that “inherent anticipation

does not require a person of ordinary skill in the art to recognize the inherent disclosure in the prior art at the time the prior art is created." *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1343 (Fed. Cir. 2005); see also *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (the "recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not distinguish a claim drawn to those things from the prior art.")

Even under a "recognition" standard, however, Hassan's arguments are contradicted by the record. The passages cited by the Examiner for descriptions of the viscosity of the adhesive (Ans. 5-6, citing Werenicz 12:22-38) explain that the low molecular weight, low-viscosity polymers are present to reduce the overall viscosity of the polymer system (Werenicz at 12:13-17) to make possible adjustment of their thermal and rheological characteristics (*id.* at 12:44-13:15). Thus, Werenicz recognized the role of viscosity and molecular weight in the disclosed hot melt adhesive compositions, and Hassan's argument on this matter is baseless.

More particularly, Hassan appears to argue that one could not reasonably conclude, "if one took the reference's particular polymer "X" having a density of "Y", and used it in a hot melt adhesive composition, and took Applicant[']s polymer '1' (Table 3, p. 40) having a density of 0.9073 g/cc, a viscosity of 1,375 cp (at 350 degrees F), a number average molecular weight (M_n) of 3,420, when used in combination with a tackifier different from the one used in the reference, and in a different concentration than that used in the reference, that the different ethylene/alpha-olefin interpolymers would produce identical hot melt adhesive compositions having the PAFT and SAFT values claimed by applicants." (Br. 29.)

This argument misapprehends the Examiner's use of the term "identical" in the argument cited *supra*. By "identical," the Examiner clearly meant "within the scope of the claimed invention." Hassan has not come forward with evidence or argument that refutes the Examiner's finding that Werenicz teaches hot melt adhesive compositions that meet the limitations—including the PAFT and SAFT values—recited in the claims. Accordingly, we are not persuaded that the evidence and argument marshaled here show reversible error in the Examiner's conclusion that the adhesive compositions described by Werenicz that are otherwise within the limitations of the claims also fall within the recited PAFT and SAFT values.

C. Summary

In view of the record and the foregoing considerations, it is:

ORDERED the rejection of claims 1 and 3-15 for obviousness-type double patenting in view of claims 1-16 of Yalvac is AFFIRMED;

FURTHER ORDERED that the rejection of claims 1 and 3-15 under 35 U.S.C. § 102(e) in view of Yalvac is AFFIRMED;

FURTHER ORDERED that the rejection of claims 1, 3-16, and 18-27 under 35 U.S.C. § 10(2)(b) in view of Werenicz is AFFIRMED;

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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